

THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Applied Ecological Services, Inc.

Serial No. 76568177

Erik W. Ibele of Neider & Boucher for applicant.

James T. Griffin, Trademark Examining Attorney, Law Office
103 (Michael Hamilton, Managing Attorney).

Before Seeherman, Quinn and Walsh, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Applied Ecological
Services, Inc. to register the mark STORMWATER TREATMENT
TRAIN for "design for others of stormwater management
systems."¹

The trademark examining attorney refused registration
under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §

¹ Application Serial No. 76568177, filed January 5, 2004,
originally alleging first use anywhere and first use in commerce
on March 21, 1996. Pursuant to an amendment filed on November
24, 2004, applicant withdrew the Section 1(a) basis and
substituted therefor an allegation, under Section 1(b), that
applicant has a bona fide intention to use the mark in commerce.

1052(e)(1), on the ground that applicant's mark, when used in connection with applicant's services, is merely descriptive thereof.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.

Applicant does not dispute that the words "stormwater treatment" are descriptive. (Brief, p. 1). Applicant contends, however, that the term "train" is not descriptive, but rather is a metaphor for a series of events or processes. Applicant points out that the excerpted articles introduced by the examining attorney show that the authors place the phrases containing the word "train" in quotation marks, or define or explain the words the first time they are cited. If the term "train" were merely descriptive, applicant argues, then it would not be necessary to explain the metaphor. According to applicant, the necessity to explicate a mark by analogy is precisely the difference between a descriptive and a suggestive mark. The use of the term "train" in applicant's mark is as a metaphor to suggest a series or techniques for treating stormwater, "as in cars of a train" (the metaphor used by the examining attorney). Applicant refers to two third-party registrations for marks containing the word "TRAIN" accompanied by descriptive terms.

The examining attorney maintains that the term "TRAIN" in applicant's mark is far more than just a metaphor, and that the mark as a whole is merely descriptive of a certain type of stormwater management system. In support of the refusal, the examining attorney submitted excerpts of various websites wherein the term "stormwater treatment train" is used to refer to a particular type of stormwater treatment system. Thus, according to the examining attorney, applicant's mark merely describes applicant's services of designing stormwater treatment trains.

A term is merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used or is intended to be used on or in connection with those goods or services, and the possible significance that the term would have to the purchaser of the goods or services because of the manner of its use or intended use. That a term may have other meanings in different contexts is not controlling. In re Polo International Inc., 51 USPQ2d 1061 (TTAB 1999); and In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). It is settled that:

....the question of whether a mark is merely descriptive must be determined not in the abstract, that is, not by asking whether one can guess, from the mark itself, considered in a vacuum, what the goods or services are, but rather in relation to the goods or services for which registration is sought, that is, by asking whether, when the mark is seen on the goods or services, it immediately conveys information about their nature.

In re Patent & Trademark Services Inc., 49 USPQ2d 1537, 1539 (TTAB 1998).

The examining attorney introduced several excerpts retrieved from third-party websites showing uses of "stormwater treatment train" or variations thereof in a merely descriptive manner:

Each...system is custom engineered for the site and utilizes a unique "treatment train" approach for pollutant removal.
(www.aquashieldinc.com)

BMPs ["Best Management Practices"] in series incorporate several stormwater treatment mechanisms in a sequence to enhance the treatment of runoff. Also called a "stormwater treatment train," they consist of a series of BMPs and natural features, each designated to treat a different aspect of runoff, maximizing pollutant removal and stormwater infiltration...This example is a prototype design of a residential development that uses a treatment train system for stormwater management...The first step in the treatment train process at the Marshall site is the effective management of stormwater on individual home sites...A stormwater treatment train can be designed to serve a multitude of ecological functions, becoming an amenity rather than a necessary utility...Treatment train design should be based on local ecology and local community directives.
(www.metrocouncil.org)

Stormwater management is a critical concern in any watershed. To address this, South Village will include an innovative ecologically designed stormwater management and detention system, known as a Stormwater Treatment Train (STT)...South Village's STT is comprised of a series of linked landscape elements that manage and treat stormwater close to where the precipitation hits the ground and continuing treatment as it runs through the property.
(www.southvillage.com)

Past studies have identified urban runoff as a major contributor to the degradation of many urban streams and rivers. The objective of this research was to characterize typical toxicant concentrations in stormwater, and investigate the effectiveness of treatment processes to control the toxicants. A prototype device (the multi-chambered treatment train, or MCTT) was tested during the final phase of this project.
(www.osti.gov)

A Multi-Chambered Stormwater Treatment Train
(www.pubs.asce.org)

The examining attorney also introduced the following excerpt from an article:

The stormwater treatment train at Prairie Crossing (Grayslake, Illinois) was designed to reduce runoff and increase quality of water in that leaving the residential development. ("On Conservation Developments and Their Cumulative Benefits," a paper presented at a national symposium "Assessing the Cumulative Impacts of Watershed Development on Aquatic Ecosystems and Water Quality," March 1996)

Based on the evidence of record, we conclude that the phrase STORMWATER TREATMENT TRAIN is merely descriptive when used in connection with the design of stormwater management systems. The evidence shows that the matter sought to be registered is used in the field to refer to a particular method or system to manage stormwater. The term

"train" is used to specifically refer to a series of elements, natural or otherwise, used for the treatment of stormwater. As used in connection with applicant's services, STORMWATER TREATMENT TRAIN merely describes services featuring the design of stormwater management systems utilizing trains, that is, stormwater treatment trains.

The two third-party registrations of TRAIN marks relied upon by applicant are not persuasive of a different result.² It is significant that the registrations involve goods far removed from the type of services involved herein. In any event, while uniform treatment under the

² Applicant originally referred to the registrations during the prosecution phase and, in response, the examining attorney did not object to the mere reference to the registrations. It was not until his appeal brief that the examining attorney objected to the registrations on the basis that copies of them were not submitted. See TBMP § 1208.02 (2d ed. rev. 2004). Thus, according to the examining attorney, the registrations were not properly made of record and should not be considered. However, the examining attorney then went on to discuss the registrations, maintaining that they do not compel reversal of the refusal. The examining attorney is deemed to have waived his right to object to the improper submission of the third-party registrations by not timely objecting to them when applicant first referred to them. Accordingly, the objection is overruled, and the registrations have been considered. TBMP § 1207.03 (2d ed. rev. 2004) ["If the applicant, during the prosecution of the application, provided a listing of third-party registrations, without also submitting actual copies of the registrations, and the examining attorney did not object or otherwise advise applicant that a listing is insufficient to make such registrations of record at a point when the applicant could cure the insufficiency, the examining attorney will be deemed to have waived any objection as to improper form."].

statute is an administrative goal, our task in this appeal is to determine, based on the record before us, whether applicant's particular matter sought to be registered is merely descriptive. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court."]; and *In re Best Software Inc.*, 58 USPQ2d 1314 (TTAB 2001).

We conclude that the applied-for mark STORMWATER TREATMENT TRAIN, as used in connection with the design for others of stormwater management systems, is merely descriptive thereof.

Decision: The refusal to register is affirmed.